

**REMARKS**

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

**I. Claim Status and Amendments**

Applicants are in receipt of a final Office Action mailed December 15, 2008, in this application. Applicants respectfully request that, if the present amendment does not place the application in condition for allowance, then the finality of the subject Office Action should be withdrawn pursuant to MPEP 706.07(d) for the following reasons.

The Office appears to have erroneously examined the wrong set of claims as evidenced by the difference in claim number between the originally filed claim set of 34 claims, the claims noted in the first Office Action of March 31, 2008 (only 33 claims noted as pending), and the claims as amended per Applicant's response mailed September 23, 2008 (in which claim 34 was noted as "Currently amended" and thus previously of record in the application).

Specifically, Applicant filed the application with 34 original claims, numbered as claims 1-34. However, it appears that the Office then substituted the IPER set of 33 claims, numbered claims 1-33, for Applicant's originally filed set, once the IPER issued (after the filing of this national

phase application), without Applicant's approval and contrary to MPEP 1893.01(a)(3), which indicates that annexes of amendments will normally be entered into the US National stage application by the Office absent a clear instruction by the applicant that annexes are not to be entered. See the Transmittal Letter and the IPER search in the USPTO's PAIR website, in which it is indicated that claims 1-34 are "Replaced by Art 34 Amdt."

It is believed that original claims 1-34 should not have been replaced, because no authorization was given by the Applicant to replace the originally filed claims 1-34 with claims 1-33. See item 7 (d) of Applicant's Transmittal Letter of June 8, 2005, which indicated that such amendments will not be made. Furthermore, to do otherwise would result in an obvious inconsistency in the claims. See MPEP 1893.01(a)(3). Nonetheless, the Office did replace the claims and issued the March 31, 2008 Office Action, which indicated that "[c]laims 1-33 are pending and under examination herein." See line 1 on page 2 of the Office Action of March 31, 2008, and item 4 of the Office Action Summary.

Applicant did not become aware that this had been done until recently and upon review of the claims as published. As a result, there seems to have been a disconnect between the claims under examination and Applicant's previous

response in which Applicants were working off of the originally filed 34 claim set.

Thus, Applicant respectfully requests clarification and the reconsideration and withdrawal of the finality of the last Office Action in the event that the present amendment does not place the application in condition for allowance.

Claims 9-15, 18-20, 26-32, and 34-36 were pending in this application when last examined and stand rejected.

Claims 1-8, 16-17, 21-25, and 33 were previously cancelled.

By way of the present amendment, Applicants have replaced the claims of record with new claims 37-54 to correspond to the subject matter indicated as allowed and to better clarify the nature of the invention. Support can be found throughout the application and in the corresponding claims 1-34, as originally filed. New independent claims 37 and 45 correspond in scope to the subject matter indicated as allowed in previous claims 9 and 19, respectively. The remaining dependent claims correspond to the previous dependent claims.

It is believed that this amendment should be entered and considered, even though the case is after final rejection, because the amended claims correspond in scope to the subject matter indicated as allowed, and thus, they should not raise

new issues requiring further consideration and/or search. No new matter has been added.

In addition, Applicant has amended the formula in original claims 8 and 18 (now new claims 37 and 45, respectively) and the specification at page 5, line 8 to correct an inadvertent typing and/or translation error when the application was translated to English. The correct terminology of the formula (I) of the subject patent application is “[ $(B-(B/S)_i-S)_j]_k-Z$ , wherein i, j and k are integers equal to or greater than 1”. The subscript “j” outside of the bracket “[“ of the original formula has been substituted by a subscript “k” in the new formula. The subscript “k” was added only to clarify the formula, but it is clear that it has the same function of the subscript “j” outside the bracket, *i.e.*, indicates the number of blocks that compose the polymer. Regarding the subscripts “i” and “j” in the corrected new formula, they indicate, as in the original formula, the number of monomer units that comprise the block copolymer. It is important to stress that the aforementioned amendments in formula (I) do not modify the scope of the invention, but rather they make it clearer and consistent. Again, the above-noted revisions are being made to correct an inadvertent typing and/or translation error when the

application was translated to English. It is believed that this revision does not add new matter.

Again, it is believed that this amendment should be entered and considered, even though the case is after final rejection, because the amended claims correspond in scope to the claims that they replace and to the subject indicated as allowed, and thus, the amendments should not raise new issues requiring further consideration and/or search.

Claims 37-54 are pending upon entry of this amendment.

Moreover, it is believed that the newly added claims define novel and unobvious subject matter under Sections 102 and 103 of 35 U.S.C., and therefore should be allowed.

Applicant respectfully requests favorable reconsideration, entry of the present amendment, and formal allowance of the claims.

## **II. Written Description Rejection under 35 U.S.C. 112**

Claims 9-15 and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for the reasons noted on page 2 of the Office Action.

This rejection is respectfully traversed. The claims now recite the degree of polydispersity of the polymers claimed.

### **III. Prior Art Rejections**

Claims 10-15 and 35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either of Moczygembra (US 5705569) or Hoshi (US 6,235,847) for the reasons on page 3 of the Office Action.

Claims 10-15 and 35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Binsbergen (US 5,229,472) for the reasons on page 3 of the Action.

Claims 18, 20, 26-32, 34, and 36 are rejected under 35 U.S.C. 102(b) as anticipated by EP 0879836 for the reasons on pages 3-4 of the Office Action.

These rejections are respectfully traversed. It is noted with appreciation that the Examiner acknowledges the indication that claims 9 and 19 would be allowable if amended or rewritten to overcome the rejection under 35 U.S.C. 112 set forth there in and to include all of the limitations of the base claim and any intervening claims.

For the sole purpose of expediting prosecution and not to acquiesce to the rejections, the present amendment obviates the rejections, since new claims 37-54 clearly include the subject matter indicated as allowed. Again, independent claims 37 and 45 correspond in scope to the subject matter indicated as allowed in previous claims 9 and 19, respectively. Therefore, it is respectfully submitted that these claims, and claims dependent therefrom, are allowable.

New claim 45, which replaces claim 19, includes the limitation of polydispersity limitation.

#### **IV. Allowable Subject Matter**

On page 5 of the Office Action, it was noted that claim 9 would be allowable if rewritten in impendent form. Claim 9 has now been rewritten to correspond to new independent claim 37. Thus, it is believed that claim 37 is now allowable.

Claim 19 was objected to as being dependent upon a rejected base claim. Claim 19 has been rewritten to correspond to new claim 45. It is believed that new claim 45 is allowable.

**V. Conclusion**

Having addressed all the outstanding issues, the amendment is believed to be fully responsive to the Office Action. It is respectfully submitted that the claims are in condition for allowance and favorable action thereon is requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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